



AP/BFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Gregory Griffin et al.

EXAMINER: Vishal A. Patel

APPL. NO.: 10/777,745

GROUP ART UNIT: 3673

FILED: February 12, 2004

ATTY DKT NO.: D5260

TITLE: Gasket

CERTIFICATE OF FIRST CLASS MAILING UNDER 37 C.F.R. §1.8(a)

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1/22/07
Date

Catherine M. Majewski
Catherine M. Majewski

Commissioner for Patents
Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF TRANSMITTAL LETTER

Dear Sir:

Transmitted herewith is an Appeal Brief under 37 C.F.R. §41.37 for the above captioned patent application. The fee required under 37 C.F.R. 41.20(b)(2) is **\$500.00**. The Director is hereby authorized to charge any fees that may be required, or credit any overpayment, to **Deposit Account No. 14-0603**. One additional copy of this sheet is enclosed.

Respectfully submitted,

Date: January 19, 2007

By:

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APPEAL BRIEF UNDER 37 C.F.R. §41.37

Dear Sir:

I. REAL PARTY IN INTEREST

International Engine Intellectual Property Company, LLC is the assignee of the present invention.

II. RELATED APPEALS AND INTERFERENCES

None known.

III. STATUS OF CLAIMS

This application was filed with eighteen (18) claims, two (2) claims were added during prosecution, and one (1) claim, claim 5, was cancelled during prosecution. Claims 1- 4 and 6-20 are pending and stand twice rejected. The rejections of claims 1- 4 and 6-20 are appealed.

IV. STATUS OF AMENDMENTS

A Final Office Action was mailed on August 22, 2006. In response, an Amendment/Response was filed by Applicant on October 20, 2006. The Amendment/Response filed after the Final Office Action has not been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A. Brief Summary

The following describes a self-retaining gasket and method of utilizing it in installation. The self-retaining gasket includes one or more elastomeric sections disposed on a metal substrate. An elastomeric ring has an inner diameter that is smaller than an outer diameter of a fastener. When the fastener is inserted into the ring, the fastener and gasket are retained to each other. When a flange for a device, such as an oil pick-up tube, is disposed between the fastener and the gasket, the gasket and fastener are retained to the flange, thereby providing easier and more reliable installation. [page 3, paragraph 0012]

A top view of a flange 101 of an oil pick-up tube 100 is shown in FIG. 1. The flange is shown with two fastener holes to facilitate installation of the oil pick-up tube 100 with two fasteners to an engine, for example, to the front cover of an engine. [page 3, paragraph 0013]

A top view of a self-retaining gasket is shown in FIG. 3. The gasket 201 comprises elastomeric material 301 disposed on a metal substrate 303 that is described in more detail with respect to FIG. 4. The elastomer 301 includes a bead 305 that extends away from the plane of the metal substrate 303, as shown in FIG. 5, generally providing a sealing function. As shown in FIG. 3, the elastomeric bead 305 forms the inner perimeter of elastomer 301 of the gasket 201. One or more elastomeric ring(s) 307 are formed to substantially align with the fastener hole(s) 103 of the flange 101. The elastomeric bead 305 and the elastomeric ring(s) 307 may be formed as one continuous elastomer or they may each be formed in separate sections. The elastomeric material 301 may be, for example, rubber. [pages 3...4, paragraph 0015]

An elastomeric ring 307 is shown formed at each end of the gasket 201. A ring 307 is advantageously formed for each fastener 205, although sufficient retention may be achieved with one or more rings 307 depending on the flange 101 and/or how many fasteners 205 are utilized. Each ring 307 has an inner diameter 309 that is smaller than the outer diameter of the section of the fastener 205 that will be inserted through the ring 307. By utilizing an inner diameter 309 that is smaller than the outer diameter of the fastener 205, the fastener 205 forms an interference fit with the ring 307, causing the fastener 205 to be retained with the gasket 201, for example, during installation. Advantageously, the size of the inner diameter

309 is chosen such that the fasteners 205 are retained with the gasket without damaging the gasket during insertion of the fasteners 205. [page 4, paragraph 0016]

A plurality of "teeth" 311 are formed along the outer perimeter of the elastomeric 301 to advantageously provide better grip between the elastomeric 301 and the metal substrate 303 at the inner perimeter of the metal substrate 303. The teeth 311 may be formed along the bead 305 and/or the ring(s) 307. A top view of a metal substrate 303 of a self-retaining gasket 201 is shown in FIG. 4. A plurality of grooves 401 are shown formed along the inner perimeter of the metal substrate 303. [pages 4...5, paragraph 0018; page 5, paragraph 0019, lines 2-3]

A perspective view of a partial cross-section of a self-retaining gasket 201 is shown in FIG. 6. Although the elastomeric bead 305 is shown over a part of the inner perimeter of the elastomer 301, the elastomeric bead 305 advantageously extends completely around the inner perimeter of the elastomer 301. The cross-section is taken along the section line 313 of FIG. 3. The teeth 311 of the elastomer 301 are shown corresponding to the grooves 401 of the metal substrate 303. Elastomer 301 is shown formed above the channel 407 after the molding process. [page 5, paragraph 0021]

B. Examples from the specification are provided in support of the independent claims.

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| 1. A gasket comprising: | |
| a metal substrate disposed along an outer perimeter of the gasket; | The self-retaining gasket includes one or more elastomeric sections disposed on a metal substrate. [paragraph 12, lines 2 and 3] The gasket 201 comprises elastomeric material 301 disposed on a metal substrate 303... [paragraph 15, lines 1-2] |
| an elastomeric bead disposed along at least a part of an interior perimeter of the metal substrate; | The elastomer 301 includes a bead 305 that extends away from the plane of the metal substrate 303, as shown in FIG. 5, generally providing a sealing function. As shown in FIG. 3, the elastomeric bead 305 forms the inner perimeter of elastomer 301 of the gasket 201. [paragraph 15, lines 3-6] |
| an elastomeric ring disposed around an opening of the metal substrate, | An elastomeric ring 307 is shown formed at each end of the gasket 201. A ring 307 is advantageously formed for each fastener 205, although sufficient retention may be achieved with one or more rings 307 depending on the flange 101 and/or how many fasteners 205 are utilized. [paragraph 16, lines 1-4] |
| wherein the elastomeric ring has an inner diameter, | Each ring 307 has an inner diameter 309 [paragraph 16, line 4] |
| wherein the opening has an opening diameter, | The flange is shown with two fastener holes [paragraph 13, lines 1 and 2] |
| and wherein the inner diameter of the elastomeric ring is smaller than the opening diameter of the opening; | Each ring 307 has an inner diameter 309 that is smaller than the outer diameter of the section of the fastener 205 that will be inserted through the ring 307. [paragraph 16, lines 4-6] |
| wherein a fastener that is disposable within the opening has an outer diameter, and wherein the inner diameter is smaller than the outer diameter of the fastener, | By utilizing an inner diameter 309 that is smaller than the outer diameter of the fastener 205, the fastener 205 forms an interference fit with the ring 307, causing the fastener 205 to be retained with the gasket 201 [paragraph 16, lines 5-8] |
| such that the fastener is retained with the gasket when the fastener is inserted in the elastomeric ring by radially compressing the elastomeric ring between the fastener and the opening. | the size of the inner diameter 309 is chosen such that the fasteners 205 are retained with the gasket without damaging the gasket during insertion of the fasteners 205 [paragraph 16, lines 8-10] |

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| 4. The gasket of claim 1, | |
| wherein the elastomeric bead and the elastomeric ring are formed of a continuous rubber material that is formed on the metal substrate. | The elastomeric bead 305 and the elastomeric ring(s) 307 may be formed as one continuous elastomer or they may each be formed in separate sections. The elastomeric material 301 may be, for example, rubber. [paragraph 15, lines 7-9] |

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| 8. A gasket comprising: | |
| a metal substrate disposed along an outer perimeter of the gasket, | The self-retaining gasket includes one or more elastomeric sections disposed on a metal substrate. [paragraph 12, lines 2 and 3] The gasket 201 comprises elastomeric material 301 disposed on a metal substrate 303... [paragraph 15, lines 1-2] |
| wherein the metal substrate has a plurality of grooves disposed along an interior perimeter of the metal substrate and an inner diameter of a fastener opening; | A plurality of grooves 401 are shown formed along the inner perimeter of the metal substrate 303. [paragraph 19, lines 2 and 3] |
| wherein the fastener opening is arranged and constructed to accommodate a fastener having an outer shaft diameter, wherein the outer shaft diameter is smaller than the inner diameter of the fastener opening; | Each ring 307 has an inner diameter 309 that is smaller than the outer diameter of the section of the fastener 205 that will be inserted through the ring 307. [paragraph 16, lines 4-6] By utilizing an inner diameter 309 that is smaller than the outer diameter of the fastener 205, the fastener 205 forms an interference fit with the ring 307, causing the fastener 205 to be retained with the gasket 201 [paragraph 16, lines 5-8] the size of the inner diameter 309 is chosen such that the fasteners 205 are retained with the gasket without damaging the gasket during insertion of the fasteners 205 [paragraph 16, lines 8-10] |
| an elastomer comprising a bead disposed along an interior perimeter of the elastomer and a ring disposed along the inner diameter of the fastener opening, | An elastomeric ring 307 is shown formed at each end of the gasket 201. A ring 307 is advantageously formed for each fastener 205, although sufficient retention may be achieved with one or more rings 307 depending on the flange 101 and/or how many fasteners 205 are utilized. [paragraph 16, lines 1-4] |

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|---|---|
| wherein a plurality of teeth are formed along an outer perimeter of the elastomer, | A plurality of "teeth" 311 are formed along the outer perimeter of the elastomeric 301 to advantageously provide better grip between the elastomeric 301 and the metal substrate 303 at the inner perimeter of the metal substrate 303. The teeth 311 may be formed along the bead 305 and/or the ring(s) 307. [paragraph 18] |
| wherein the plurality of teeth are formed in the plurality of grooves, | The teeth 311 of the elastomer 301 are shown corresponding to the grooves 401 of the metal substrate 303. [paragraph 21, lines 5-6] |
| and wherein the ring has an inner diameter that is smaller than both the inner diameter of the fastener opening and the outer shaft diameter of the fastener, | By utilizing an inner diameter 309 that is smaller than the outer diameter of the fastener 205 [paragraph 16, lines 5-6] |
| such that the fastener is retained with the gasket when the fastener is inserted in the elastomeric ring. | the fastener 205 forms an interference fit with the ring 307, causing the fastener 205 to be retained with the gasket 201 [paragraph 16, lines 7-8] |

| | |
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| 13. A gasket comprising: | |
| a metal substrate disposed along an outer perimeter of the gasket, | The self-retaining gasket includes one or more elastomeric sections disposed on a metal substrate. [paragraph 12, lines 2 and 3] The gasket 201 comprises elastomeric material 301 disposed on a metal substrate 303... [paragraph 15, lines 1-2] |
| wherein the metal substrate has a plurality of grooves disposed along an interior perimeter of the metal substrate and along an inner diameter of a fastener opening, | A plurality of grooves 401 are shown formed along the inner perimeter of the metal substrate 303. [paragraph 19, lines 2 and 3] |
| wherein the fastener opening is sized to cooperate with a specific fastener, such that the specific fastener has an outer shaft diameter, and the inner diameter of the fastener opening is larger than the outer shaft diameter; | Each ring 307 has an inner diameter 309 that is smaller than the outer diameter of the section of the fastener 205 that will be inserted through the ring 307. [paragraph 16, lines 4-6] By utilizing an inner diameter 309 that is smaller than the outer diameter of the fastener 205, the fastener 205 forms an interference fit with the ring 307, causing the fastener 205 to be retained with the gasket 201 [paragraph 16, lines 5-8] the size of the inner diameter 309 is chosen such that the fasteners 205 are retained with the gasket without damaging the gasket during insertion of the fasteners 205 [paragraph 16, lines 8-10] |

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| an elastomeric bead comprising a plurality of teeth disposed along an outer perimeter of the elastomeric bead, | A plurality of "teeth" 311 are formed along the outer perimeter of the elastomeric 301 to advantageously provide better grip between the elastomeric 301 and the metal substrate 303 at the inner perimeter of the metal substrate 303. The teeth 311 may be formed along the bead 305 and/or the ring(s) 307. [paragraph 18] |
| wherein the elastomeric bead is disposed along the interior perimeter of the metal substrate, | An elastomeric ring 307 is shown formed at each end of the gasket 201. A ring 307 is advantageously formed for each fastener 205, although sufficient retention may be achieved with one or more rings 307 depending on the flange 101 and/or how many fasteners 205 are utilized. [paragraph 16, lines 1-4] A plurality of "teeth" 311 are formed along the outer perimeter of the elastomeric 301 to advantageously provide better grip between the elastomeric 301 and the metal substrate 303 at the inner perimeter of the metal substrate 303. The teeth 311 may be formed along the bead 305 and/or the ring(s) 307. [paragraph 18] |
| and wherein the plurality of teeth are disposed in some of the plurality of grooves; | The teeth 311 of the elastomer 301 are shown corresponding to the grooves 401 of the metal substrate 303. [paragraph 21, lines 5-6] |
| a first elastomeric ring comprising at least two teeth disposed along an outer perimeter of the first elastomeric ring, | A ring 307 is advantageously formed for each fastener 205, although sufficient retention may be achieved with one or more rings 307 depending on the flange 101 and/or how many fasteners 205 are utilized. [paragraph 16, lines 2-4] |
| wherein the first elastomeric ring is disposed in the fastener opening and near a first end of the metal substrate, | An elastomeric ring 307 is shown formed at each end of the gasket 201. [paragraph 16, line 1] |
| wherein the at least two teeth are disposed in at least two of the plurality of grooves, | The teeth 311 of the elastomer 301 are shown corresponding to the grooves 401 of the metal substrate 303. [paragraph 21, lines 5-6] |
| and wherein the first elastomeric ring has an inner ring diameter that is smaller than the outer shaft diameter; | Each ring 307 has an inner diameter 309 that is smaller than the outer diameter of the section of the fastener 205 that will be inserted through the ring 307. [paragraph 16, lines 4-6] |
| a second elastomeric ring comprising two or more teeth disposed along an outer perimeter of the second elastomeric ring, | A ring 307 is advantageously formed for each fastener 205, although sufficient retention may be achieved with one or more rings 307 depending on the flange 101 and/or how many fasteners 205 are utilized. [paragraph 16, lines 2-4] |

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| wherein the second elastomeric ring is disposed in an additional fastener opening that is near a second end of the metal substrate, | An elastomeric ring 307 is shown formed at each end of the gasket 201. [paragraph 16, line 1] |
| wherein the two or more teeth are disposed in two or more of the plurality of grooves, | The teeth 311 of the elastomer 301 are shown corresponding to the grooves 401 of the metal substrate 303. [paragraph 21, lines 5-6] |
| and wherein the second elastomeric ring has an additional inner ring diameter that is smaller than an additional outer shaft diameter of an additional fastener. | Each ring 307 has an inner diameter 309 that is smaller than the outer diameter of the section of the fastener 205 that will be inserted through the ring 307. [paragraph 16, lines 4-6] |

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-4 and 6-7 stand rejected under 35 U.S.C. §112, second paragraph. Claims 1-3 and 6-12 stand rejected under 35 U.S.C. §103(a) given Schenk (U.S. Patent No. 6,553,664) in view of Farnam (U.S. Patent No. 3,811,689) and further in view of Fucci et al. (U.S. Patent No. 4,819,954). Claims 1-3 and 6-12 stand rejected under 35 U.S.C. §103(a) given Belter (U.S. Patent No. 5,168,047) in view of Farnam and in further view of Fucci. Claim 4 stands rejected under 35 U.S.C. §103(a) given Schenk in view of Farnam and Fucci, and further in view of Inciong (U.S. Patent No. 6,543,787). Claims 13-20 stand rejected under 35 U.S.C. §103(a) given Belter in view of Farnam and Fucci, and further in view of Nenzell (U.S. Patent No. 2,795,444). Claims 13-20 stand rejected under 35 U.S.C. §103(a) given Schenk in view of Farnam and Fucci, and further in view of Nenzell.

VII. ARGUMENT

A. Claims 1-4 and 6-7 stand rejected under 35 U.S.C. §112, second paragraph.

In cases where the scope of the claimed subject matter can be determined by one having ordinary skill in the art, and the scope is as accurate as the subject matter permits, the claims are clear and in accordance with 35 U.S.C. §112, second paragraph (*Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565).

In this case, the Examiner contends that it is unclear how a gasket can have a fastener, because a gasket assembly can have a fastener but not a gasket. Appellant respectfully submits that claim 1 describes a gasket, not a gasket assembly. A gasket is what Applicants regard as their invention, in accordance with 35 U.S.C. §112, second paragraph.

Claims 1 and 8, and all claims that depend therefrom, are clear and in accordance with 35 U.S.C. §112, second paragraph because the scope of the claimed subject matter can be determined by one having ordinary skill in the art, and is as accurate as the subject matter permits. One with ordinary skill in the art interpreting the claims would be able to make and use a gasket having an opening surrounded by an elastomeric ring having an inner diameter that is smaller than an outer diameter of the fastener.

Hence, claims 1 and 8 are clear, or at least as clear as the subject matter permits, and the rejection based on 35 U.S.C. §112, second paragraph, should be removed.

B. Claims 1-3 and 6-12 stand rejected under 35 U.S.C. §103(a) given Schenk, in view of Farnam, and further in view of Fucci

The Examiner's rejection seems to rely on the combination of the teachings of Schenk with the rings of Farnam and the dimensioning for rings of Fucci. Before traversing the rejection, the Applicant feels it would be helpful to briefly describe and characterize the Farnam and Fucci references.

Farnam uses bushings, or insert members (24), that "are of a **high strength** low thermal conductivity material so as to **retain the proper size for the bolt hole**, as well to support the flange claiming loads of the heat insulating structure" [column 2, lines 47-51; emphasis added]. Farnam does not teach deformation of an elastomeric ring for retention of

a fastener; in fact, Farnam teaches the opposite since the insert members (24) are made of a high strength material so as to retain the proper size for the bolt hole.

Fucci teaches use of a *plastic* fastener component that is adapted to be molded into a gasket. The *plastic* fastener of Fucci, or component (10), is "molded as a unitary structure from a suitable **plastic** such as nylon" [column 2, lines 28-29; emphasis added]. As is well known in the art, *plastic* components or materials are not *elastic* components or materials. An elastic (or elastomeric) component is capable of recovering its size and shape after deformation, contrary to a plastic component that is capable of being deformed continuously and permanently in any direction.

Therefore, the resulting combination of Schenk, Farnam, and Fucci, might yield rings formed around openings in a gasket that are made of a high strength material and that retain the proper size for the bolt hole, as taught by Farnam, and even if a fastener having an outer diameter that is larger than the inner diameter of the ring the fastener were inserted in the hole, then the ring would deform plastically, as taught by Fucci. Hence, neither Schenk, Farnam, and/or Fucci, alone or in combination, teach *an elastomer comprising ... a ring disposed along the inner diameter of the fastener opening*, as stated in claims 1 and 8, and also in claim 13.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488

In this case, the first criterion fails in that Farnam teaches that the rings or inserts are made of a high strength material so as to retain the proper size for the bolt hole rather than being deformable so as to retain a fastener therein.

The second criterion fails because there is no reasonable expectation for success in that the resulting combination of Farnam and Fucci will yield a device that will not operate to elastically deform rings surrounding fastener openings, but rather, the resulting combination will have resilient rings that either do not deform, or that deform plastically.

Finally, the third criterion fails in that the combined references fail to teach or suggest all the claim limitations, for example *an elastomer comprising ... a ring disposed along the inner diameter of the fastener opening*, and moreover, the teaching or suggestion to make the claimed combination is absent from the prior art as especially evidenced by the teaching away from the claimed combination by Farnam.

The Examiner has made a 35 U.S.C. §103 rejection, yet has failed to establish a prima facie case for obviousness, and further fails to provide the teachings necessary to fill the gaps in these references in order to yield the invention as claimed. The Examiner has provided mere hindsight as motivation, which is not sufficient to meet the burden of sustaining a 35 U.S.C. §103 rejection. Therefore, the present invention is not obvious in light of any combination of Schenk, Farnam, and/or Fucci.

Thus, claims 1-3 and 6-12 of the present invention are not taught or suggested by Schenk, Farnam, and/or Fucci. Combining these references fails to teach or yield the invention as claimed. The combination of these references fails to teach or suggest all the elements of the claims. Further, one of skill in the art would not be motivated to make such a combination, especially in light of one of the references, Farnam, teaching away from such a combination. Therefore, the present invention is not obvious in light of any combination of Schenk, Farnam, and/or Fucci, and the rejection under 35 U.S.C. §103(a) should be removed.

C. Claims 1-3 and 6-12 stand rejected under 35 U.S.C. §103(a) given Belter, in view of Farnam, and in further view of Fucci

The basis of this rejection is again a combination of the gasket of Belter with, as above, the rings of Farnam and the dimensioning for rings of Fucci. As Appellant has shown above, the combination of Farnam and Fucci references fails to teach or yield *an elastomer comprising ... a ring disposed along the inner diameter of the fastener opening* as stated in independent claims 1, 8, and 13. Therefore, any combination of Farnam and/or Fucci with a reference, in this case Belter, to show an elastomeric ring disposed along fastener holes, the ring having an inner diameter that is smaller than an outer diameter of the fastener, fails to teach or yield the invention as claimed. The resultant combination might yield rings formed around openings in a gasket that are made of a high strength material and that retain the

proper size for the bolt hole, as taught by Farnam, and even if a fastener having an outer diameter that is larger than the inner diameter of the ring the fastener were inserted in the hole, then the ring would deform plastically, as taught by Fucci.

Appellant notes that the rejections under 35 U.S.C. §103(a) set forth by the Examiner for claims 1-3 and 6-12 interchangeably use the Belter and Schenk references, combined in the same fashion with other references. Under M.P.E.P §904.03, the Examiner:

“is not called upon to cite *all* references that may be available, but only the “best.” (37 CFR 1.104(c).) Multiplying references, any one of which is as good as, but no better than, the others, adds to the burden and cost of prosecution and should therefore be avoided.” [MPEP §904.03, emphasis and cites in original]

The Examiner's piecemeal rejections are not warranted based on the art cited because there are no major technical rejections on any of the grounds listed under MPEP 707.07(g). The Examiner is merely multiplying references, without justifying the need to cite multiple references or technically distinguishing between the multiple references.

Therefore, claims 1 and 8, and claims 2, 3, 6-7, and 9-12 that depend therefrom, are allowable over Belter in view of Farnam and further in view of Fucci, and may be passed to allowance.

D. Claim 4 stands rejected under 35 U.S.C. §103(a) given Schenk, in view of Farnam, in further view of Fucci, and in further in view of Inciong

Appellant has shown above that the combination of Schenk in view of Farnam and Fucci fails to teach or suggest all the elements of the claims. Hence, reliance by the Examiner on the combination of Schenk in view of Farnam and Fucci, with further combination of Inciong, fails to teach the combination of claim 4 because it fails to teach elements of claim 1. Specifically, the limitation of *wherein the elastomeric bead and the elastomeric ring are formed of a continuous rubber material that is formed on the metal substrate*, as stated in claim 4, are not taught because the combination does not teach an elastomeric ring that deforms when a fastener is inserted therein such that the fastener is retained.

Moreover, Inciong teaches axial compression of elastomeric features in his gasket, and does not teach nor imply having *a fastener that is disposable within the opening and radially compressing the elastomeric ring between the fastener and the opening when the*

fastener is inserted in the elastomeric ring as stated in independent claim 1. Inciong does not teach or suggest retaining fasteners with an elastomeric ring of a gasket.

Appellant also notes that this rejection relies on four (4) separate references that alone or in combination fail to teach all elements of the claims. The Examiner has had ample opportunity to produce references that either alone or in combination teach elements of the claims, but has failed to do so. In an Advisory Action mailed on 2/15/2006, and again in another Advisory Action mailed on 10/31/2006 following reopening of prosecution at Applicant's Request for Continued Examination, Examiner stated that a further search would be required. Both the initial search, and the additional search performed after prosecution was reopened failed to yield references that anticipate the claimed subject matter of the instant application. Because this rejection of claim 4 fails to teach all elements of the claims, and further, because the Examiner has failed to show a prima facie case of obviousness, this rejection is improper, and claim 4 should be allowed.

E. Claims 13-20 stand rejected under 35 U.S.C. §103(a) given Belter, in view of Farnam, in view of Fucci, and further in view of Nenzell

The Examiner relies on a combination of the "teeth" taught by Nenzell with the combination of the teachings of Belter, Farnam, and Fucci. Appellant has shown that the combination of Belter in view of Farnam and Fucci fails to teach or suggest all the elements of the independent claims. Hence, reliance by the Examiner on the combination of Belter in view of Farnam and Fucci, with further combination of Nenzell, fails to teach *wherein the first elastomeric ring has an inner ring diameter that is smaller than the outer shaft diameter*, as stated in claim 13 and as shown above. Therefore, claim 13 is allowable. Moreover, claims 14-20 depend on an independent claim that is shown to be allowable, and for this reason, are themselves allowable.

F. Claims 13-20 stand rejected under 35 U.S.C. §103(a) given Schenk in view of Farnam and Fucci, and further in view of Nenzell.

The Examiner relies on a combination of the "teeth" taught by Nenzell with the combination of the teachings of Schenk, Farnam, and Fucci. Appellant has shown that the combination of Schenk in view of Farnam and Fucci fails to teach or suggest all the elements of the independent claims. Hence, a reliance by the Examiner on the combination of Schenk

in view of Farnam and Fucci, with further combination of Nenzell, fails to teach *wherein the first elastomeric ring has an inner ring diameter that is smaller than the outer shaft diameter*, as stated in claim 13 and as shown above. Therefore, claim 13 is allowable. Moreover, claims 14-20 depend on an independent claim that is shown to be allowable, and for this reason, are themselves allowable.

Applicant apologizes for noting the following yet again, but considers the following necessary to mention. As stated above pertaining to the duplication of rejections based on the Schenk and Belter references used interchangeably in rejections under 35 U.S.C. §103(a) for claims 1-3 and 6-12, the Examiner is duplicating rejections, based on the same two references used interchangeably, for the rejections under 35 U.S.C. §103(a) for claims 13-20. As stated above, this duplication lacks meritorious justification and merely adds to the burden and cost of prosecution.

For the foregoing reasons, Appellant requests removal of the rejection under 35 U.S.C. §103(a) and allowance of claims 13-20.

G. Summary of Argument

As shown above, claims 1-4 and 6-7 comply with the requirements under 35 U.S.C. §112, second paragraph. Claims 1-3 and 6-12 are not anticipated under 35 U.S.C. §103(a) given any of the references cited by the Examiner, alone or in combination. Claim 4 is not anticipated under 35 U.S.C. §103(a) in view of the references. Further, claims 13-20 are not anticipated under 35 U.S.C. §103(a) given any of the references cited by the Examiner, considered alone or in combination. Withdrawal of the rejections under 35 U.S.C. §112, second paragraph, and 35 U.S.C. §103(a) and a Notice of Allowance of claims 1-4 and 6-20 are hereby respectfully requested.

VIII. CLAIMS APPENDIX

Claims 1-4 and 6-20 are involved in the appeal and are reproduced below.

1. A gasket comprising:

a metal substrate disposed along an outer perimeter of the gasket;

an elastomeric bead disposed along at least a part of an interior perimeter of the metal substrate;

an elastomeric ring disposed around an opening of the metal substrate, wherein the elastomeric ring has an inner diameter, wherein the opening has an opening diameter, and wherein the inner diameter of the elastomeric ring is smaller than the opening diameter of the opening;

wherein a fastener that is disposable within the opening has an outer diameter, and wherein the inner diameter is smaller than the outer diameter of the fastener, such that the fastener is retained with the gasket when the fastener is inserted in the elastomeric ring by radially compressing the elastomeric ring between the fastener and the opening.

2. The gasket of claim 1, wherein a plurality of teeth disposed along an outer perimeter of the elastomeric bead correspond with a plurality of grooves disposed along at least a section of the interior perimeter of the metal substrate.

3. The gasket of claim 1, wherein a plurality of teeth disposed along an outer perimeter of the elastomeric ring correspond with a plurality of grooves disposed along at least a segment of the interior perimeter of the metal substrate.

4. The gasket of claim 1, wherein the elastomeric bead and the elastomeric ring are formed of a continuous rubber material that is formed on the metal substrate.

6. The gasket of claim 1, wherein the gasket is capable of fitting to a flange having a fastener hole, such that when the fastener is inserted through the fastener hole and the elastomeric ring, the gasket and fastener are sufficiently attached to the flange to permit installation of the fastener without the gasket and fastener falling off the flange.

7. The gasket of claim 6, wherein the gasket is disposable between an engine cover and an oil pick-up tube attached to the flange.

8. A gasket comprising:

a metal substrate disposed along an outer perimeter of the gasket, wherein the metal substrate has a plurality of grooves disposed along an interior perimeter of the metal substrate and an inner diameter of a fastener opening; wherein the fastener opening is arranged and constructed to accommodate a fastener having an outer shaft diameter, wherein the outer shaft diameter is smaller than the inner diameter of the fastener opening;

an elastomer comprising a bead disposed along an interior perimeter of the elastomer and a ring disposed along the inner diameter of the fastener opening, wherein a plurality of teeth are formed along an outer perimeter of the elastomer, wherein the plurality of teeth are formed in the plurality of grooves, and wherein the ring has an inner diameter that is smaller than both the inner diameter of the fastener opening and the outer shaft diameter of the fastener, such that the fastener is retained with the gasket when the fastener is inserted in the elastomeric ring.

9. The gasket of claim 8, further comprising a depression formed in the metal substrate.

10. The gasket of claim 8, wherein the gasket is capable of fitting to a flange having a fastener hole, such that when the fastener is inserted through the fastener hole and the ring, the gasket and fastener are sufficiently attached to the flange to permit installation of the fastener without the gasket and fastener falling off the flange.

11. The gasket of claim 8, wherein the gasket is disposable between an engine cover and an oil pick-up tube attached to the flange.

12. The gasket of claim 1, wherein the inner diameter of the elastomeric ring is smaller than an inner diameter of an opening formed the metal substrate into which opening the elastomeric ring extends.

13. A gasket comprising:

a metal substrate disposed along an outer perimeter of the gasket, wherein the metal substrate has a plurality of grooves disposed along an interior perimeter of the metal substrate and along an inner diameter of a fastener opening, wherein the fastener opening is sized to cooperate with a specific fastener, such that the specific fastener has an outer shaft diameter, and the inner diameter of the fastener opening is larger than the outer shaft diameter;

an elastomeric bead comprising a plurality of teeth disposed along an outer perimeter of the elastomeric bead, wherein the elastomeric bead is disposed along the interior perimeter of the metal substrate, and wherein the plurality of teeth are disposed in some of the plurality of grooves;

a first elastomeric ring comprising at least two teeth disposed along an outer perimeter of the first elastomeric ring, wherein the first elastomeric ring is disposed in the fastener opening and near a first end of the metal substrate, wherein the at least two teeth are disposed in at least two of the plurality of grooves, and wherein the first elastomeric ring has an inner ring diameter that is smaller than the outer shaft diameter;

a second elastomeric ring comprising two or more teeth disposed along an outer perimeter of the second elastomeric ring, wherein the second elastomeric ring is disposed in an additional fastener opening that is near a second end of the metal substrate, wherein the two or more teeth are disposed in two or more of the plurality of grooves, and wherein the second elastomeric ring has an additional inner ring diameter that is smaller than an additional outer shaft diameter of an additional fastener.

14. The gasket of claim 13, wherein the elastomeric bead, the first elastomeric ring, and the second elastomeric ring, are formed of a continuous rubber material that is formed on the metal substrate.

15. The gasket of claim 13, further comprising a depression formed in the metal substrate.

16. The gasket of claim 13, wherein the gasket is capable of fitting to a flange having a first fastener hole and a second fastener hole, such that when the fastener is inserted through the first fastener hole and the first elastomeric ring and the additional fastener is inserted through the second fastener hole and the second elastomeric ring, the gasket, the first fastener, and the additional fastener are sufficiently attached to the flange to permit installation of the first fastener and the additional fastener without the gasket and first fastener and the additional fastener falling off the flange.

17. The gasket of claim 16, wherein the gasket is disposable between an engine cover and an oil pick-up tube attached to the flange.

18. The gasket of claim 1, wherein the elastomeric ring extends radially inwardly of the opening in the metal substrate.

19. The gasket of claim 1, wherein the inner diameter of the elastomeric ring forms an interference fit with the fastener.

20. The gasket of claim 8, wherein the inner diameter of the ring forms an interference fit with the fastener.

IX. EVIDENCE APPENDIX

No evidence has been submitted pursuant to 37 C.F.R §1.130, §1.131, or §1.132.

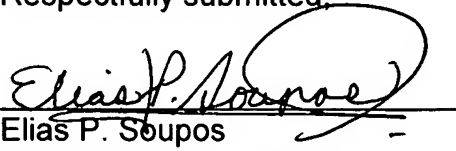
X. RELATED PROCEEDINGS APPENDIX

No related proceedings are submitted herewith.

Respectfully submitted,

Date: January 19, 2007

By:

A handwritten signature in black ink, appearing to read "Elias P. Soupos", written over a horizontal line.

Elias P. Soupos

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